



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,760	12/21/2005	Hiroshi Shimbori	SHIGA7.039APC	1637

20995 7590 03/18/2008
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
----------	--------------

1795

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcarter@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No. 10/561,760	Applicant(s) SHIMBORI, HIROSHI	
	Examiner Sin J. Lee	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-22 is/are allowed.
- 6) ☒ Claim(s) 1 and 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants canceled claims 2 and 3.
2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 9, applicants recite that the weight ratio of B1 to B2 is within a range of 1:1 to 1:10. There is no support for this limitation (it is the Examiner's position that applicants meant to say that the ratio is within a range of 1:1 to 10:1).

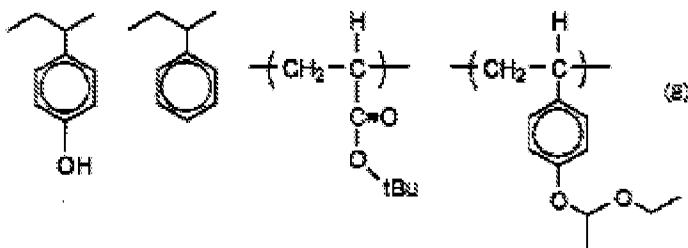
Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimori et al (JP 2001-142214 and its machine-assisted English translation of the Japanese document as provided by JPO).

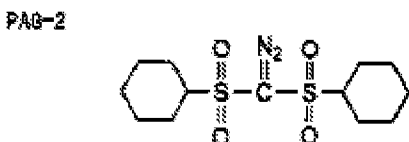
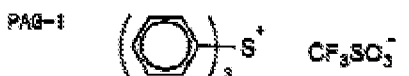
Fujimori teaches (see abstract and pg.11 of the Japanese document) the following resin used in a positive photoresist composition:



In Examples 13, 14, 16 and 17, Fujimori teaches a photoresist composition containing the resin (8) shown above, a photoacid generator and a nitrogen-containing compound (see Table 3 on pg.49 of Japanese document). Fujimori also teaches that his photoacid

Art Unit: 1795

generator can be used in a mixture of two or more (see [0126] of English translation). In those Examples 13, 14, 16 and 17, Fujimori uses the following photoacid generators:



Since Fujimori already teaches that his photoacid generators can be used in a mixture of two or more, it would have been obvious to one skilled in the art to use the mixture of PAG-1 and PAG-2 in equal amounts in Fujimori's composition with a reasonable expectation of obtaining a positive photoresist composition having improved balance between the dense and coarse patterns of a resist pattern and improved line edge roughness. Fujimori also teaches present pattern forming method in [0164] and [0169] (see English translation). Thus, Fujimori's teaching renders obvious present inventions of claims 1 and 4-16.

Allowable Subject Matter

7. Claims 17-22 are allowed. Fujimori does not teach or suggest presently required magnetic film of claims 17 and 20. Also, Takeda et al (US 2002/0111459 A1) or Hirotooshi et al (JP 2001-081137), both of which were previously cited in IDS, does not teach or suggest present magnetic film of claims 17 and 20 (also, in Takeda'459, the weight ratio of B1 to B2 is 1:2 (see Example 4 in Table 1), and in Hirotooshi et al, the weight ratio of B1 to B2 is 17:1 (see Example 2).

Response to Arguments

8. By pointing to comparative examples, applicants argue that present claims are not obvious in view of Fujimori because of the unexpected advantages that are obtained when present (B1) and (B2) are used, and when the specific weight ratio of these two is used. However, applicants' such argument is found to be unpersuasive because the comparison was not made to the closest prior art. See MPEP 716.02(e). Also, the comparison made is not commensurate in scope with the broadest claim. See MPEP 716.02(d).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


Art Unit: 1795

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sin J. Lee/

Primary Examiner, Art Unit 1795

March 1, 2008

Application Number 	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/561,760	SHIMBORI, HIROSHI	
	Examiner	Art Unit	
	Sin J. Lee	1795	